

Application No.: 10/698,676  
Reply to Office Action of: January 13, 2006

### **REMARKS**

Claims 1-26 are currently pending in this application. By this Amendment claims 1, 12, 24, and 26 have been amended. No new matter has been added via this amendment, and support for the amendments to claims 1, 12, 24, and 26 can be found at least at paragraph 74 and figure 11. Applicant respectfully requests that this amendment should be considered and entered at this time because although the claims are being amended, the Examiner has previously considered arguments related to the claim amendments.

### **§ 102 Rejection of the Claims**

Claims 1, 3-8, 10 12-20 and 22-26 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Desai, U.S. Patent No. 6,231,591. Applicant respectfully traverses this rejection.

Although Applicant does not necessarily agree with or concede the correctness of this rejection, claims 1, 12, 24, and 26 have been amended herein. Claim 1 has been amended as follows:

1. (Currently amended) A method of delivering a denervating agent to a prostate gland, the method comprising:
  - inserting an imaging apparatus into a rectum of a patient, wherein the imaging apparatus **has a longitudinal axis and** includes a hole at the distal tip;
  - generating one or more images of the prostate gland via the imaging apparatus;
  - maneuvering a needle through the hole at the distal tip of the imaging apparatus and through a rectal wall of the patient, **wherein the needle extends out of the imaging apparatus parallel the longitudinal axis of the imaging apparatus;**
  - positioning a distal end of the needle in proximity to the prostate gland based on the one or more images;
  - inserting the distal end of the needle into the prostate gland; and
  - delivering the denervating agent to the prostate gland via a lumen of the needle.

Applicant respectfully asserts that Desai does not anticipate newly amended claim 1 because it does not disclose a needle that "extends out of the imaging apparatus parallel the longitudinal axis of the imaging apparatus", as is recited in newly amended claim 1. The Examiner points to Figure 25 of Desai, as seen there, the needle 306 exits the apparatus at an

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angle, that is given by E in Figure 25. Because Desai does not disclose a needle that "extends out of the imaging apparatus parallel the longitudinal axis of the imaging apparatus", and instead discloses a needle that exits the apparatus at an angle E, it does not anticipate claim 1.

Although not explicitly raised by the Examiner, the Applicant also notes that Desai does not render newly amended claim 1 obvious. As discussed above, Desai does not disclose a needle that that "extends out of the imaging apparatus parallel the longitudinal axis of the imaging apparatus", Desai also does not suggest such a needle, and in fact explicitly teaches against it.

At column 18, line 22 through line 40, Desai discusses the angle E of Figure 25. It is stated there that "the angle 'E' of the electrode 306 from the primary electrode axis 'F' is an important feature of the present invention" (column 18, lines 22-24). The angle in cooperation with the extendable and retractable electrode "makes it possible to insert the electrode in body tissue located away from the axis 'F'" (column 18, lines 24-27). In order to make the apparatus of Desai function in this manner, a curved end 345 is included for directing the electrode at the angle "E".

As seen here, Desai does not suggest a device with a needle that "extends out of the imaging apparatus parallel the longitudinal axis of the imaging apparatus", and modifying the device of Desai would make it unusable for its intended purpose. Furthermore, Desai actually teaches away from such a configuration because the ability to insert the electrode in body tissue located away from the axis "F" is an important feature of the invention. Therefore, Desai does not render claim 1 obvious.

Claims 12, 24, and 26 have been amended in similar fashions to claim 1, and therefore, the same arguments exist why they are neither anticipated nor obvious in light of Desai. In light of the amendments made herein and the comments offered herein, Applicant respectfully requests that this rejection be withdrawn.

### § 103 Rejection of the Claims

Claims 2, 9, 11 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,231,591, in view of 6,365,164, to Schmidt. Applicant respectfully traverses this rejection.

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Applicant reiterates the comments offered above, and note that Schmidt fails to remedy the shortcomings of Desai. Applicant therefore respectfully asserts that the claims as amended are non-obvious. Withdrawal of this rejection is respectfully requested.

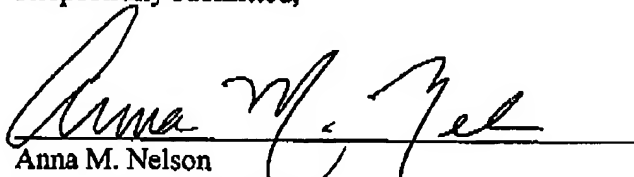
In view of the foregoing amendments, Applicants respectfully request reconsideration and allowance of the claims as all rejections have been overcome. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 763.505.0409 or by E-mail at [anna.m.nelson@medtronic.com](mailto:anna.m.nelson@medtronic.com) with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit Account No. 13-2546.

Respectfully submitted,

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